

## REMARKS

The above amendments and these remarks are responsive to the Office action dated June 2, 2004. Claims 1-9 are pending in the application. In the Office action, the Examiner objected to claim 5 in that “the channel being formed of two layers” is not shown in the drawings or discussed in the specification. Claims 1-7 are rejected under 35 U.S.C. § 102(b) as being anticipated by Davis (WO 91/04684) and claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis in view of Cook (U.S. Patent No. 2,785,413). In view of the amendments above, and the remarks below, applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

### Claim objections

Claim 5 is objected to because of an informality. The Examiner asserts that “the channel being formed of two layers” is not shown in the drawings or discussed in the specification. As discussed on page 8 of Applicant’s specification, and shown in Figs. 2 and 3, a fabric swatch (16, 26) may be formed or sewn on either the inside or the outside of the sock. For example, Applicant’s specification states that fabric swatch 16 may be attached to sock 10 along the entire perimeter of the swatch such that the fabric swatch together with the slits forms a channel 18 (page 8, lines 6-8). Applicant therefore respectfully submits that claim 5 is shown in the drawings and discussed in the specification. However, in the interest of expediting allowance of the claims, Applicant has amended claim 5 to clarify that the channel “is defined by two layers of material.”

**Rejections under 35 USC § 102**

Claims 1-7 are rejected under 35 U.S.C. § 102(b) as being anticipated by Davis.

Applicant submits that claims 1-3, as amended, are not anticipated by Davis since Davis fails to disclose or suggest first and second openings positioned through the body of the sock. Davis states that a strip of elastic material is attached to the body of the sock at each end of the strip to form a loop. The disclosure of Davis is focused entirely on external sock attachments that alleviate the discomfort of prior designs (see page 1, lines 12-17). Davis states that the “elastic strip of material is formed separately from the sock itself and is simply attached to the sock during manufacture by stitching to the sock at each end of the strip.” (page 4, lines 7-9). Further, Davis requires the elastic strip to be attached longitudinally and secured at both ends to prevent the loop from moving relative to the sock. (page 3, line 15 – page 4, line 5). Consequently, not only does Davis fail to suggest first and second openings positioned through the body of the sock, Davis actually teaches away from forming openings through the body of the sock. For at least these reasons, Applicant respectfully submits that claims 1-3 are allowable.

Applicant submits that claims 4-6, as amended, are also not anticipated by Davis since Davis fails to disclose or suggest a channel that is integral with the body of the sock. As previously noted, Davis focuses entirely on external sock attachments that are stitched on to the sock. The elastic strip in Davis is therefore not integral with the sock. For at least these reasons, Applicant respectfully submits that claims 4-6 are allowable. Claim 7 is cancelled, thus rendering its rejection moot.

**Rejections under 35 USC § 103**

Claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis in view of Cook. Claim 8 is cancelled and its subject matter incorporated into claim 6. The rejection of claim 8 is therefore moot. Accordingly, claim 9 is amended to depend from claim 6.

In order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine reference teachings. Such motivation cannot be based on a hindsight reconstruction of the applicant's invention. Second, there must be a reasonable expectation of success. Third, the prior art reference(s) must teach or suggest all the claim limitations. (See, e.g. MPEP § 2143)

Applicant submits that the combination of Davis and Cook fails to teach or suggest all the limitations of the rejected claims.

Davis describes an elastic strip that is attached to the body of a sock. The strip forms an expandable loop through which the matching sock may be threaded. The strip is formed separately from the sock itself and is simply attached to the sock during manufacture by stitching each end of the strip to the sock. (See pg. 4, lines 7-9) The Office action asserts that Davis provides a sock with a channel formed in the body. The Office action states that Davis fails to teach a swatch of fabric attached to the inside of the sock, but that it would have been obvious to have provided the fabric swatch of Davis secured to the inside of a sock as taught by Cook.

Applicant respectfully submits that the combination of Davis and Cook fails to teach a channel formed in a sock body by attaching a swatch to the inside of the body of the sock, the sock body including first and second openings to provide access to the channel. Both Davis and Cook teach attachment of elastic materials to a sock. Neither reference contains any teaching or suggestion to include openings in the body of the sock.

Moreover, Applicant respectfully submits that there is no proper motivation to combine the elastic external strip of Davis with the garter-like elastic band of Cook.

A suggestion, teaching or motivation to combine or modify references “must be clear and particular.” In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) (citations omitted). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’” of a suggestion, teaching or motivation to combine references. Id. (citation omitted). Furthermore, the Federal Circuit cautioned that combining prior art references without such a teaching, suggestion or motivation, “simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.” Id. (citation omitted). The law is “clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” Id. (citation omitted).

In Dembiczak, the invented technology was a trash bag that resembles a jack-o-lantern. Like the present case, Dembiczak did not involve highly complex technology. However, the Federal Circuit made clear that preventing rejections based on hindsight reconstruction “is especially important in the case of less technologically complex

inventions, where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome ....’” *Id.* (quoting W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983)).

Applying the law to the case at hand, Applicant submits that the claim rejections based on Davis in view of Cook are improper because there is no teaching, suggestion, or motivation in either reference to modify the structures in those references. Specifically, the elastic band in Cook is oriented transversely (circumferentially) so that it also functions as a garter to retain the sock on the wearer’s leg. (Col. 1, lines 15-30). In contrast, the elastic strip of Davis is oriented longitudinally to prevent discomfort from the fabric “rucking.” (Page 3, lines 15-29). Thus, not only is there an absence of a suggestion in either reference to form a combination as asserted by the Examiner, the references themselves actually teach away from such a combination. For at least these reasons, Applicant respectfully submits that claim 9 is allowable.

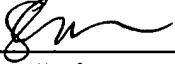
New claims 12-15 recite a sock comprising inner and outer layers with first and second openings passing through the outer layer. As previously discussed, neither Davis nor Cook teach or suggest first and second openings passing through a portion of a sock. Claims 12-15 are therefore believed to be allowable. Support for the new claims can be found throughout the specification and claims as originally filed. No new matter is added.

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants respectfully request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner

has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

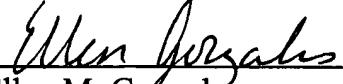
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Respectfully submitted,

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